

### Remarks

This is responsive to the Office Action mailed May 16, 2006. The amendments and remarks serve to more particularly point out and distinctly claim that which is the patentable subject matter of the present embodiments. The amendments and remarks are proper, do not introduce new matter, do not require additional searching, are not narrowing in view of a prior art rejection, and place the application in proper condition for allowance of all pending claims.

In an absence of the reconsideration requested herein, the remarks further serve to explain why this case is not in condition for appeal.

### Rejection Under 35 U.S.C. §102(b)

Claims 1-2, 11-13, 19-20, and 23-28 stand rejected as being anticipated by Biche '348. This rejection is respectfully traversed.

#### Claim 1

Applicant reiterates that the Examiner has failed to substantiate a prima facie case of anticipation because newly cited Biche '348, like the previously cited art, does not identically disclose all the recited elements of claim 1, which include at least the following:

*a slide having a linearly stationary proximal end fixed in rotation with the pivot block...*

*a gripping block...linearly moveable....  
(excerpts of claim 1, emphases added)*

These structural differences between the present embodiments as claimed and what Biche '348 discloses are what make the improvements of the present embodiments possible, and are what patentably distinguish over Biche '348. Biche '348 is typical of related art devices that engage a disc caddy containing discs that are positioned with their flat surfaces disposed vertically (see, for example, Biche '348 col. 1 lines 27-30; col. 2 lines 6-10; col. 4 lines 33-38; col. 5 lines 31-34; and col. 6 lines 26-29). Contrarily, the present embodiments as claimed permits transporting the disc caddy in an orientation such that the discs it contains are positioned almost horizontally, such as about three degrees from horizontal (see, for example, specification pg. 10 lines 16-19; Applicant's Response

of 2/21/2006, pg. 14) For presenting the discs in the caddy to a process, reducing the rotation from about ninety degrees to about three degrees advantageously reduces cycle time and reduces handling forces on the discs.

After reading Biche '348 the skilled artisan would readily recognize that the Examiner mischaracterizes it in stating: "Biche et al. disclose a...slide having a linearly stationary proximal end fixed in rotation with a pivot block 34A (or 42 as it supports pivoting 20A, 43, & 44)...." (Office Action of 5/16/2006, pg. 2). The language of claim 1 *fixed in rotation with* clearly means that the *linearly stationary proximal end* of the *slide* rotates precisely with the *pivot block*. This language expressly excludes structures in which one rotates independently of the other, and in which neither rotate. The Examiner reads the *pivot block* of claim 1 on either the plate 34A or the top plate 42 of Biche '348. He reads the *slide* of claim 1 on the slide rail 43 of Biche '348. However, the skilled artisan readily recognizes that the slide 43 of Biche '348 does not pivot at all; rather, it is attached to the side plate 40 (Biche '348, col. 4 lines 8-9). Therefore, the slide 43 is not *fixed in rotation* with the plate 34A because the plate 34A rotates independently of the proximal end of the slide. Also, the slide is not *fixed in rotation* with the top plate 42 because neither one rotates.

After reading Biche '348 the skilled artisan would also readily recognize that the Examiner mischaracterizes claim 1 by completely ignoring the recited feature *a gripping block attached to the distal end of the slide and thereby...linearly moveable....* The Examiner reads the *gripping block* of claim 1 on the drawer front 20A of Biche '348, which is not linearly moveable by the slide 43, but is rather rotationally moveable:

Thus, as is evident from FIGS. 4A and 4B, as motor/encoder 46 drives slider 44 from its rearward position (FIG. 4A) to its forward position (FIG. 4B), drawer front 20A rotates approximately 90° about a horizontal axis until it reaches the position shown in FIG. 4B.

(Biche '348, col. 4 lines 21-26, emphasis added)

Applicant acknowledges that Biche '348 also notes in passing that this movement can include translational movement, but that translational movement is not critical to the Biche '348 invention. Accordingly, Applicant has amended claim 1 without prejudice solely in order to more particularly point out and distinctly claim that the present

embodiments contemplate the *gripping block...linearly moveable coextensively with the slide distal end*. The amendment distinguishes the present embodiments as claimed as expressly requiring the linear movement to be coextensive with the slide distal end. The skilled artisan would readily recognize the distinction over Biche '348, in which the drawer front 20A moves rotationally and possibly translationally, and thereby is not *linearly moveable coextensively with the slide distal end*.

Therefore, the Examiner has failed to substantiate a *prima facie* case of anticipation because Biche '348 does not identically disclose *a slide having a linearly stationary proximal end fixed in rotation with the pivot block*. Biche '348 furthermore cannot substantiate a *prima facie* case of anticipation because it does not identically disclose *a gripping block...linearly moveable coextensively with the slide distal end* as claimed.

Accordingly, the examination resulting in this rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a)(1). Because the final rejection is based on mischaracterizations of what the claim actually recites and what the cited reference actually discloses, it also does not provide a reason for the rejection that is useful in aiding Applicant to judge the propriety of continuing the prosecution. 37 CFR 1.104(a)(2) Reconsideration and withdrawal of the rejection of claim 1 are respectfully requested.

Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Only a travesty in equities would require Applicant to proceed to appeal on a rejection based on mischaracterizations of what the claim recites and what the cited reference discloses. Accordingly, this case is not in condition for appeal due at least to these unresolved factual issues: (1) the Examiner has failed to make the requisite evidentiary showing in the record substantiating a *prima facie* case of anticipation, (2) the factual mischaracterization of the cited reference, and (3) the factual mischaracterization of what the claim recites.

Claim 19

In rejecting claim 19 the Examiner merely restates the claim language without providing any reason whatsoever how Biche '348 can be reasonably viewed as disclosing both the *tilting a gripping block* step and the *moving the gripping block linearly* step. Accordingly, the examination resulting in the final rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a)(1). The final rejection also does not provide a reason for the rejection that is useful in aiding Applicant to judge the propriety of continuing the prosecution. 37 CFR 1.104(a)(2)

Nevertheless, Applicant has amended claim 19 without prejudice solely in order to more particularly point out and distinctly claim that the *moving a gripping block* step is performed in a particular order with respect to the *tilting a gripping block* step and the *gripping a disc caddy* step. It will be noted that *tilting the gripping block* and *pivoting the gripping block* have been changed to *pivoting the gripping block* and *reverse pivoting the gripping block* in order to more particularly point out and distinctly claim the patentable subject matter of the present embodiments. It will also be noted that the linear movement of the present embodiments, as distinguished from the possibility of translational movement in Biche '348 as discussed above, is more particularly set forth by the amendment *moving the gripping block linearly while preserving the parallel relationship....*

The Examiner has failed to substantiate a *prima facie* case of anticipation because Biche '348 does not identically disclose both the *pivoting a gripping block* step and the *moving a gripping block* step as claimed. Reconsideration and withdrawal of the rejection of claim 1 are respectfully requested.

Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*.

Only a travesty in equities would require Applicant to proceed to appeal on a rejection based on no substantiated evidence whatsoever forming the basis of the rejection, but merely the Examiner restating the claim language. Accordingly, this case is not in

condition for appeal due at least to the unresolved factual issue that the Examiner has failed to make the requisite evidentiary showing in the record substantiating a *prima facie* case of anticipation.

#### Claim 28

The *means for presenting* element of claim 28 invokes 35 U.S.C. §112, sixth paragraph. Accordingly, the Examiner is obliged to construe the means clause as covering the disclosed structure and equivalents thereof performing the identical function of the claimed embodiments. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. However, the Examiner rejected claim 28 on the same basis as claim 1. The Examiner's failure to construe claim 28 in accordance with Section 112 paragraph six is clearly reversible error.

When properly construed it is clear that Biche '348 does not anticipate the *means for presenting* element of claim 28. As discussed above, Biche '348 discloses no structure that is capable of grippingly engaging a disc caddy while it is transporting discs in a nearly horizontal disposition. More particularly, Biche '348 discloses no structure whatsoever that is capable of tilting the gripper block to match the tilt of the disc caddy, and then linearly move the tilted gripper block orthogonally to the disc caddy in order to engage it. When the means element is properly construed, it is clear that the cited references do not teach or suggest any structure capable of the identical function as the present embodiments as claimed. Accordingly, independent claim 28 is allowable over the art of record.

The Examiner has failed to substantiate a *prima facie* case of anticipation because Biche '348 does not identically disclose *means for presenting* as claimed. Reconsideration and withdrawal of the rejection of claim 28 are respectfully requested.

Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*.

Only a travesty in equities would require Applicant to proceed to appeal on a rejection of a means plus function claim that has not been properly construed in accordance with Section 112 paragraph six. Accordingly, this case is not in condition for appeal due at least to the unresolved legal issue that the Examiner has failed to substantiate a prima facie case of anticipation by misconstruing the claim.

**Rejection Under 35 USC 103(a)**

Claims 3-10 stand rejected as being unpatentable over Biche '348 in view of Choi '700. This rejection is respectfully traversed because these claims are allowable as depending from an allowable independent claim, for reasons above, and reciting additional features thereto. Reconsideration and withdrawal of these rejections are respectfully requested.

Claim 21 stands rejected as being unpatentable over Matsushima '675 in view of Smith '623. This rejection is respectfully traversed.

The *means for presenting* element of claim 21 invokes 35 U.S.C. §112, sixth paragraph. Accordingly, the Examiner is obliged to construe the means clause as covering the disclosed structure and equivalents thereof performing the identical function of the claimed embodiments. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. However, the Examiner did not do so, but rather read the *means for presenting* entirely on the chamber 18 of Matsushima '675. The Examiner's failure to construe claim 21 in accordance with Section 112 paragraph six is clearly reversible error.

When properly construed it is clear that Matsushima '675 does not anticipate the *means for presenting* element of claim 21. Like Biche '348, Matsushima '675 discloses no structure that is capable of grippingly engaging a disc caddy while it is transporting discs in a nearly horizontal disposition. More particularly, Matsushima '675 discloses no structure whatsoever that is capable of tilting the gripper block to match the tilt of the disc caddy, and then linearly move the tilted gripper block orthogonally to the disc caddy in order to

grippingly engage it. When the means element is properly construed, it is clear that the cited references do not teach or suggest any structure capable of the identical function as the present embodiments as claimed. Accordingly, independent claim 21 is allowable over the art of record.

The Examiner has failed to substantiate a *prima facie* case of anticipation because Matsushima '675 does not teach or suggest *means for presenting* as claimed. Reconsideration and withdrawal of the rejection of claim 21 are respectfully requested.

Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*.

Only a travesty in equities would require Applicant to proceed to appeal on a rejection of a means plus function claim that has not been properly construed in accordance with Section 112 paragraph six. Accordingly, this case is not in condition for appeal due at least to the unresolved legal issue that the Examiner has failed to substantiate a *prima facie* case of anticipation by misconstruing the claim.

### **Conclusion**

This is a complete response to the Office Action mailed May 16, 2006. The Applicant requests reconsideration and withdrawal of the rejection of all pending claims.

Absent allowance, Applicant has also submitted herewith a request for telephone interview, to be conducted before the next action on the merits. The interview is necessary to resolve the issues identified herein that make this case not in condition for appeal.

The Examiner is invited to contact the Attorneys listed below should any questions arise concerning this response.

Respectfully submitted,

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